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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,352

10/04/2006

Gail Petuna Risbridger

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6430

23389

7590

03/05/2008

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EXAMINER

DAVIS, MINH TAM B

ART UNIT

PAPER NUMBER

1642

MAIL DATE

DELIVERY MODE

03/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,352	<b>Applicant(s)</b> RISBRIDGER ET AL.	
	<b>Examiner</b> MINH-TAM DAVIS	<b>Art Unit</b> 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 51-56, 61, 62, 67-75 and 78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10, 12, 51-56, 61-62, 67-75, 78 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The response of 01/14/08 is acknowledged.

Claims 1-10, 12, 51-56, 61-62, 67-75, 78 are pending.

After review and reconsideration, the restriction requirement of 07/13/07 has been vacated, and replaced with the following restriction requirement.

#### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group A, claim(s) 1-10, 12, drawn to a method for detecting a cancer, by detecting the inhibin protein. A method for detecting each cancer, as cited in claim 10, constitutes a single, distinct invention.

Group B, claim(s) 1-10, 12, drawn to a method for detecting predisposition to a cancer, by detecting the inhibin protein. A method for detecting predisposition to each cancer, as cited in claim 10, constitutes a single, distinct invention.

Group C, claim(s) 1-10, 12, drawn to a method for detecting a cancer, by detecting the inhibin nucleic acid. A method for detecting each cancer, as cited in claim 10, constitutes a single, distinct invention.

Group D, claim(s) 1-10, 12, drawn to a method for detecting predisposition to a cancer, by detecting the inhibin nucleic acid. A method for detecting predisposition to each cancer, as cited in claim 10, constitutes a single, distinct invention.

Group E, claim 51, drawn to an inhibin nucleic acid.

Group F, claims 51-54, 78, drawn to an antibody to or a modulator of an inhibin protein.

Group G, claims 55-56, 61-62, 67-72, 74-75, drawn to a method for modulating invasiveness or treating cancer, using a modulator of inhibin protein. A method for modulating the invasiveness of or treating each cancer constitutes a single, distinct invention.

Group H, claims 55-56, 61-62, 67-69, 73, 75, drawn to a method for modulating invasiveness, or treating cancer, using an inhibin nucleic acid, or its modulator. A method for modulating invasiveness of or treating each cancer as recited in claim 56 constitutes a single, distinct invention.

Group I, claims 61-62, drawn to a prophylaxis or treating of predisposition to cancer development, using a modulator of inhibin protein. A method for prophylaxis or treating predisposition of each cancer as recited in claim 62 constitutes a single, distinct invention.

Group J, claims 61-62, drawn to a prophylaxis or treating of predisposition to cancer development, using a modulator of inhibin nucleic acid. A method for prophylaxis or treating predisposition of each cancer as recited in claim 62 constitutes a single, distinct invention.

Group K, claim 78, drawn to a modulator of inhibin nucleic acid.

The inventions listed as Groups A-K do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

According to PCT Rule 13.2, unity of invention exists only when the shared same or corresponding technical feature is a contribution over the prior art. The inventions listed as groups A-K do not relate to a single general inventive concept because they lack the same or corresponding special technical feature. The technical feature of the claimed invention, inhibin or its modulator lacks novelty and does not make a contribution over the prior art. WO 98/47526, of record, teaches a method for modulating cell growth, by administering inhibin or its antagonist, or agent that modulates the expression of inhibin, wherein the inhibin may be alpha-inhibin (abstract, p6, last line).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LARRY HELMS can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MINH-TAM DAVIS  
February 19, 2008

/Larry R. Helms/

Supervisory Patent Examiner, Art Unit 1643